



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/013,096	12/06/2001	Tetsuo Nishimoto	393032029100	9570

7590

01/22/2004

David L. Fehrman  
Morrison & Foerster LLP  
35th Floor  
555 W. 5th Street  
Los Angeles, CA 90013

EXAMINER

ABDELWAHED, ALI F

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/013,096

Applicant(s)

NISHIMOTO, TETSUO

Examiner

Ali Abdelwahed

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,9 and 11-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8, 9, 11, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,746,602 to Kikinis in view of U.S. Patent No. 5,752,880 to Gabai et al.

Kikinis discloses the claimed invention except for, regarding claim 12, the input interface further receiving from outside the electronic toy, first instructing information for instructing that predetermined control information having been stored in the memory should be replaced with the received control information, or second instructing information that the received control information should be additionally stored into the memory. However, Gabai et al. teaches an interactive electronic doll comprising the aforementioned limitations (see column 8, lines 49-62). Therefore, it would have been

Art Unit: 3712

obvious to one having ordinary skill in the art at the time the invention was made to modify the doll of Kikinis, in view of Gabai et al., such that it would provide the doll of Kikinis with the aforementioned limitations for the purpose of providing a variety of instructions to the doll to manipulate the stored information in the memory and the received control information.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis in view of U.S. Patent No. 6,149,490 to Hampton et al.

Kikinis discloses the claimed invention except for, regarding claim 14, the computer or processor being provided in the electronic toy. However, Hampton et al. teaches an interactive electronic doll comprising the aforementioned limitation (see figs.1-22, and respective portions of the specification). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the doll of Kikinis, in view of Hampton et al., such that it would provide the doll of Kikinis with the aforementioned limitation for the purpose of enclosing the computer or processor within the toy doll for enhancing the mobility of the doll.

### ***Response to Arguments***

Applicant's arguments filed on October 29, 2003 have been fully considered but they are not persuasive.

In response to Applicant's arguments concerning the rejections made to claims 1-14. Examiner responds by noting to Applicant that Kikinis in view of Gabai et al. does in fact disclose all of the claimed limitations recited in the corresponding above claims. Kikinis does in fact disclose a program stored in the memory of the doll (see column 2, line 50--column 4, line 54), and that the program is selected in accordance with a type of a sensor-detected external stimulus, and that an empirical value is generated by the doll based on a signal generated by a sensor on the doll (see column 5, line 17--column 8, line 60).

Gabai et al. was merely used in combination with Kikinis to teach the concept of having the input interface further receiving from outside the electronic toy, first instructing information for instructing that predetermined control information having been stored in the memory should be replaced with the received control information, or second instructing information that the received control information should be additionally stored into the memory. Furthermore, Gabai et al. also discloses a program stored in the internal memory of the toy (see column 7, lines 3-37 and column 9, lines 9-23), and that an empirical value is generated in the memory of the toy based on a signal generated by a sensor on the toy (see column 7, line 38--column 8, line 65).

Hampton et al. was merely used in combination with Kikinis to teach the concept of having the computer or processor provided in the electronic toy.

Examiner therefore reasserts the rejection.

**Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Abdelwahed whose telephone number is (703) 305-3311. The examiner can normally be reached Monday through Friday from 9:00 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

AA  
01/15/2004



DERRIS H. BANKS  
SUPERVISOR/EXAMINER  
TECHNOLOGY CENTER 3700